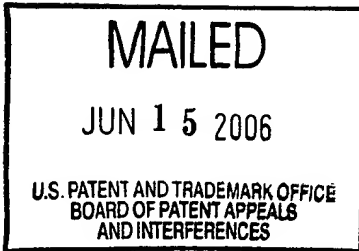


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JULIA MACLACHLAN

Application 09/997,347

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on June 14, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Appeal Brief was filed on November 8, 2005.

37 CFR § 41.37 states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

....

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented

by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following sections are missing:

- 1) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and
- 2) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

A supplemental brief that is in compliance with § 41.37(c) is required. For more information, see the United States Patent and Trademark website www.uspto.gov, and, in particular, the web page entitled "More Information on the Rules of Practice Before the Board of Patent Appeals and Interferences, Final Rule" located at the following URL:

www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html

An Examiner's Answer was mailed January 19, 2006 in response to the Appeal Brief filed November 8, 2005. Pursuant to a memorandum dated April 29, 2002 by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy:

Effective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where: (1) a rejection is supported in whole or part by an abstract without reference to the underlying document, . . . ; or (2) a rejection is supported in whole or part by a

prior art document not in the English language, unless accompanied by a translation of the prior art document into English.

This IFW is not in compliance with the above because it does not contain an English translation for the Japanese reference to Yoshinori, No. 2001-14639, dated May 29, 2001, or the French reference to Anderson, No. 2793889, dated November 24, 2000, both of which were relied upon by the Examiner in her rejection of the claims.

In addition, a Supplemental Declaration under 37 CFR § 1.131 was filed on May 11, 2005. It is not apparent from the record whether or not this Declaration has been considered by the examiner.

Finally, § 1207.01 of the Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 3, August 2005) states:

On the examiner's answer, below the primary examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. This will make the record clear that an appeal conference has been held. [Emphasis added.]

The Examiner's Answer mailed January 19, 2006 does not comply with the above requirement.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) for notification to appellant to submit a supplemental Appeal Brief which includes the "Evidence Appendix" and the "Related Proceedings Appendix";
- 2) for consideration of the supplemental Appeal Brief;

- 3) for providing certified English language translations for the Japanese reference to Yoshinori, No. 2001-14639, dated May 29, 2001, and the French reference to Anderson, No. 2793889, dated November 24, 2000;
- 4) having complete copies of these two translations scanned into the IFW and furnished to appellant;
- 5) for consideration of the Supplemental Declaration filed May 11, 2005;
- 6) for issuance of a revised Examiner's Answer which takes corrective action regarding the appeals conference; and
- 7) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 

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